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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,241	06/16/2000	Yukio Yamakawa	3620-4006	2778

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New York, NY 10154-0053

EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/595,241

Applicant(s)

YAMAKAWA ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 16 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 2-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/595,241.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 1 drawn thermoplastic non-woven roll, classified in class 442, subclass 328.
  - II. Claims 2-4 drawn to process for making thermoplastic non-woven roll, classified in class 264, subclass 176.1 and 210.1.
  - III. Claims 5-9, drawn to apparatus used to make thermoplastic non-woven roll, classified in class 425, subclass various.

2. The inventions are distinct, each from the other because:

The inventions of Group I and Group II are related as product and process for making and are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method as claimed can be employed to make a materially different product such as non-elastic non-woven fabric rolls.

The inventions of Group II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used for processing a non-elastic non-woven roll.

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The inventions of Group I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case apparatus can be used to make a non-elastic non-woven roll.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with James P. Demers on May 16<sup>th</sup> 2002a provisional election was made with traverse to prosecute the invention of Non-woven thermoplastic elastomer fabric roll, claim 1. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102 (b) as being anticipated by Suzuki et al., US 5,814,569 and Sabee, US 4,910,064.

Suzuki et al. discloses a non-woven elastic fabric (Abstract). The reference discloses a prior art method used to form elastic non-wovens having elasticity in the cross direction that includes orienting staple fibers by combing and piling according to a carding method (Column 1, lines 56-67, and Column 2, line 1). The elastic non-woven comprises conjugate filaments of a polyester polymer and a polyolefin polymer having a sheath-core arrangement (Column 4, lines 34-36). Suitable polyolefin polymers include various low, medium, and high polyethylene and polypropylene. The manufacturing process includes the steps of accumulating said conjugate filaments on a conveyor to form a web, partially heating to form a filamentous fleece having heat-bonded areas and applying a heat drawing to said filamentous fleece (Column 4, lines 18-29). Step 4 in the flow diagram of figure 1 teaches winding up the elastic non-woven to form a roll. Suzuki et al. further teaches that each of the steps in the flow diagram of figure 1 is carried out continuously on a production line (Column 11, lines 44-54).

The Sabee patent is directed to a non-woven web comprising a number of continuous filaments that are stabilized by melt-blown fibers to create a coherent web. Sabee discloses depositing the melt-blown fibers on one or both sides of the continuous filaments, and cross-laying two or more webs to form a laminate (Abstract and Figure 1). The continuous filaments may be made from a variety of textile materials such as cotton and rayon as well as thermoplastic polymers (Column 7, lines 53-56). Sabee discloses pulling the stabilized web from the exit draw roll by a cross lapper, cross layer, heated embossing rolls, or a conventional winder (Column 5, lines 23-26 and Column 15, lines 36-38 and Figure 1).

The claimed limitation of "tension required to unroll the non-woven fabric" is not given patentable weight at this time. The claim is directed to a product not a method of unrolling the product. The presence of process limitations in product claims, in which the product does not otherwise patentably distinguish over the prior art, cannot impart patentability to the product. *In re Stephens*, 145 USPQ 656

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls  
May 22, 2002



CHERYL A. JUSKA  
PRINCIPAL EXAMINER